

Appl. No. 09/675,427
• Amdt. dated August 23, 2004
Reply to Office action of April 22, 2004

REMARKS

Reconsideration of this application is respectfully requested.

The Official Action states that, "The office denies Applicants priority claim under 35 U.S.C. 119(e) to U.S. provisional applications 60,166,242 filed on November 18th, 1999."

The Official Action improperly failed to apply the correct test for determining whether the individual claims are entitled to the benefit of priority of the provisional application. M.P.E.P. § 201.11 sets forth the six conditions for the priority claim.

1. The disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.
2. Copendency
3. Reference to the provisional application
4. Common inventor(s)
5. Priority claim must be made within 4 months of filing or 16 months of the provisional filing; and
6. English translation if the provisional is in a non-English language (not applicable).

There has been no assertion by the Patent and Trademark Office (PTO) that Applicant has failed to comply with any of these six criteria for a priority claim. Requirement 6 is not applicable, and there is no question that requirements 2 through 5 are met.

Moreover, with regard to the first requirement, the PTO has not alleged that the provisional application 60/166,242 fails to provide support as required under 35 U.S.C. § 112 for any of claims 1-10 of this application. Applicant has carefully studied the claims 1-10, and compared the claims to the contents of the provisional application. Having made this comparison, Applicant submits that all of the claims are disclosed in the provisional application sufficiently to satisfy § 112.

M.P.E.P. § 2163.01 explains the criteria for satisfying the written description requirement of 35 U.S.C. § 112, first paragraph:

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The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The Provisional application clearly meets this requirement for each individual claim, and the PTO has not alleged that any of the claims lacks a written description of an enabling disclosure in the Provisional Application.

For example, all of the claim 1-10 are adequately supported by page 3, page 4, and page 5, lines 1-16. Pages 8 and 9 provide another example. It is clear from these passages that Applicant possessed the invention now claimed by claims 1-10 when the provisional application was filed.

Instead of analyzing whether each individual claim is disclosed in the provisional application, the Official Action merely points to informalities in the provisional application, and assumes that informalities can be used as a surrogate for applying the criteria of M.P.E.P. § 201.11.

The Action states that there is "missing/incomplete disclosure", and cites a missing version number of "pdPca User's Manual," recitation of 'XXX' for the last paragraph of section VII, and recitation of "Figure/Table from Phil. Something about SPACE complexity of correlation matrix rep." However, even without the version number of the Manual, the number of variables in the last paragraph of section VII, and the missing Figure/Table, the text of the

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provisional application discloses the subject matter now claimed in claims 1-10 with an enabling disclosure.

The Action observes that the provisional application improperly attempts to incorporate two references (p.6) and 16 references (p. 11). Applicant submits that even without any of the documents incorporated by reference, one of ordinary skill in the art would have appreciated that Applicant possessed the invention now claimed, and that Applicant provided an enabling disclosure of these claims within the four corners of pages 1-11 of the provisional application.

The Action generally refers to "numerous inconsistency between the provisional application and the instant application." Assuming for purpose of argument that this is correct, none of the alleged inconsistencies prevent pages 1-11 of the provisional application from providing sufficient disclosure of the subject matter now claimed in claims 1-10 in order to enable one of ordinary skill in the art to practice the invention of claims 1-10 without undue experimentation. None of the inconsistencies would prevent one of ordinary skill in the art from recognizing that at the time the provisional application was filed, Applicant possessed the invention of claims 1-10.

Because claims 1-10 are adequately supported by the provisional application sufficiently to satisfy 35 U.S.C. § 112, first paragraph, claims 1-10 are entitled to the benefit of the filing date of the provisional application.

Information Disclosure Statement

Applicant submits herewith an information disclosure statement including the 17 references requested by the Examiner.

Applicant respectfully traverses the characterization of these references as, "essential." As explained fully above, none of the references is essential. The text within the four corners of the provisional application, without any of the documents incorporated by reference, would have enabled one of ordinary skill in the art to practice the invention, and would have conveyed to one of ordinary skill that the inventors possessed what is now claimed.

Rejection under 35 U.S.C. § 102

Claims 2, 3, 7 and 8 were rejected under § 102 as being anticipated by Zanella et al.

First, Applicants note that, because claims 1-10 are entitled to the benefit of the November 18, 1999 filing date of the provisional application, Zanella et al. is not available as prior art under 35 U.S.C. § 102(b), because Zanella was published on June 12, 1999, less than one year before the filing date of Applicant's provisional application.

Applicant submits herewith a Statement of Carlo Guardiani under 37 CFR § 1.132 disqualifying the Zanella paper as prior art. In the Statement, Dr. Guardiani explains that, to the extent that the Zanella paper discloses any subject matter currently claimed in this application, Dr. Guardiani conceived that subject matter. Dr. Guardiani further explains that none of the other authors of the Zanella paper contributed to conception of the claims; their contributions were either performed under Dr. Guardiani's direction, or were directed to subject matter that is not claimed in this application.

In view of Dr. Guardiani's statement, Zanella et al. was not published before Dr. Guardiani's date of invention, because all of the claimed concepts in Zanella et al. were invented by Dr. Guardiani himself. Thus, Zanella et al. is not available as prior art under 35 U.S.C. § 102(a) either.

None of the other sections of § 102 are in any way applicable to render Zanella et al. available as prior art with respect to the present application. The invention was not abandoned or concealed under § 102(c), patented in another country under § 102(d), disclosed in a patent application filed by another under § 102(e), invented by another under § 102(f), or reduced to practice under § 102(g).

Thus, Zanella et al. is not available as prior art, and the rejection under § 102 must be withdrawn.

Rejection under 35 U.S.C. § 103

Claims 1, 4-6, and 9-10 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,356,861 (Singhal et al.) in view of Zanella et al. and further in view of C. Guardiani et al., Design for Manufacturability: A Two-Step analytic Modeling Approach."

As noted above, in view of Applicant's priority claim and Dr. Guardiani's Declaration, Zanella et al. is not available as prior art with respect to claims 1-10. Therefore, the rejections under 35 U.S.C. § 103 should be withdrawn for the same reasons set forth above.

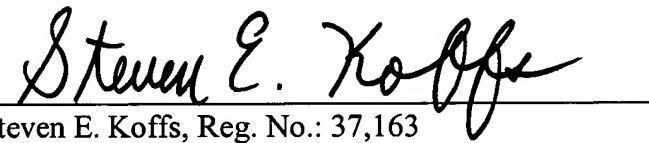
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In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Early notification to that effect is respectfully requested.

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679**.

Respectfully submitted,

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